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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,211	03/23/2000	Atsushi Kawai	44376-029	1134

20277 7590 01/29/2003

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EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/533,211

Applicant(s)

KAWAI ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Freedman (US 4,839,829).

With regard to claim 13, Freedman discloses an image forming system (system 10, col 4, lines 25-41) comprising: a printing unit (second terminal 36 comprising hard copy printer 40, col 6, lines 37-42 and col 7, lines 51-61) for forming additional images (col 10, lines 11-14) in addition to document images (which reads on printing "work") (col 4, lines 25-41); an alteration means (programmed computer 20) for altering printing fees for the document images when the additional images are formed (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the

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graphic or the advertisement to be inserted.) (col 10, lines 15-19); and a display unit (display unit 14) for displaying information concerning the printing fees altered by said alteration means (which reads on providing the requester with information regarding various job costs) (col 10, lines 19-24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman (US 4,839,829) in view of Markowitz (US 5,513,254).

With regard to claim 12, Freedman discloses an image forming system (system 10, col 4, lines 25-41) comprising: a printing unit (second terminal 36 comprising hard copy printer 40, col 6, lines 37-42 and col 7, lines 51-61) for forming additional images (col 10, lines 11-14) in addition to document images (which reads on printing "work") (col 4, lines 25-41); an alteration means (programmed computer 20) for altering printing fees for the document images when the additional images are formed (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted.) (col 10, lines 15-19).

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Freedman does not clearly teach a memory unit that stores multiple additional images.

Markowitz discloses a telephone network carrying a facsimile transmission that modifies the users facsimile transmission by incorporating at least one advertisement with the users facsimile transmission that includes a memory unit (data bases 115 and 117) that stores multiple additional images (col 3, lines 49-50 and col 4, lines 2-9).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Freedman to include the memory unit that stores multiple additional images taught by Markowitz. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Freedman by the teaching of Markowitz to the advertisements match the resolution of the users information being transmitted as taught by Markowitz in col 4, lines 2-9.

Allowable Subject Matter

4. Claims 1-11 are allowed.

Claim 1 identifies the uniquely distinct feature "an alteration means for altering the printing fees for the document images based on times required for forming the additional images".

Claims 2-9 depend upon an allowed base claim.

Claim 10 identifies the uniquely distinct feature "a mode selection unit for selecting an additional image mode that forms only the additional images without printing any document images".

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Claim 11 depends upon an allowed base claim.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:


Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

Twyler Lamb



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January 27, 2003